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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/069,605 | 02/26/2002 | Keith M Skubitz | 284.00010101 | 3442 |
| 26813 | 7590 | 11/06/2003 | EXAMINER | |
| MUETING, RAASCH & GEBHARDT, P.A. | | | TURNER, SHARON L. | |
| P.O. BOX 581415 | | | ART UNIT | |
| MINNEAPOLIS, MN 55458 | | | PAPER NUMBER | |

1647

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/069,605 | Applicant(s) SKUBITZ ET AL. | |
| | Examiner Sharon L. Turner | Art Unit 1647 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restriction

1. Claims 1-45 are pending.

Improper Markush

2. Prior to setting forth the restriction requirement, it is pointed out that applicants have presented instant claims in improper Markush format, see *Ex parte Markush*, 1925 C.D. 126, *In re Weber*, 198 USPQ 334 and MPEP 803.02 and 806.04.

“Since the decisions in *In re Weber* **, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention, *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.”

The claims are improperly set forth as the genus claims encompass multiple patentably distinct inventions, which fail to share the characteristics of a genus, i.e., a common utility and a substantial structural feature essential to the disclosed utility. Alternatively, the claims define multiple structurally distinct compounds capable of different use, with different modes of operation, different function and different effects. A reference against one of the claimed components or methods would not be a reference against the other. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because the claims define inventions which are not proper species.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18 and 45, in part, drawn to the first (elected) special technical feature peptide and first appearing use of the peptide.

Group II, claim(s) 1-10, 19-22 and 45, in part drawn to the second method of use of the first (elected) special technical feature peptide.

Group III, claim(s) 1-10, 23-26 and 45 in part, drawn to the third method of use of the first (elected) special technical feature peptide.

Group IV, claim(s) 1-10, 27-31 and 45 in part, drawn to the fourth method of use of the first (elected) special technical feature peptide.

Group V, claim(s) 1-10, 32-35 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group VI, claim(s) 1-10, 36 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group VII, claim(s) 1-10, 37 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group VIII, claim(s) 1-10, 38 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group IX, claim(s) 1-10, 39 and 45 in part, drawn to the fifth method of use of the

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first (elected) special technical feature peptide.

Group X, claim(s) 1-10, 40 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group XI, claim(s) 1-10, 41 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group XII, claim(s) 1-10, 42 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group XIII claim(s) 1-10, 43 and 45 in part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

Group XIV, claim(s) 1-10, 44 and 45 n part, drawn to the fifth method of use of the first (elected) special technical feature peptide.

4. Furthermore, in addition to the election of one of the above V groups, further restriction is required under PCT Rule 13.1 to delineate the molecular embodiment to which the claims will be restricted in accordance with the elected group:

For each of Groups I-XIV above, a single designated amino acid composition (SEQ ID NO:) is required to be designated to which the search will be limited.

Applicants should designate one SEQ ID NO: selected from 1-187.

5. The inventions listed as Groups I-XIV and SEQ ID NO's 1-187 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the peptides differ in sequence structure, length, function, effects and capable use. The methods use different steps and different reagents corresponding to the

distinct special technical features, and exhibit different effects, functions and outcomes.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated groups I-XIV and a single molecular embodiment (sequence) from SEQ ID NO's 1-187 as set forth above to which the claims will be restricted, even though the requirement is traversed. Applicant is advised that neither I-XIV nor the single molecular embodiment (sequence) of SEQ ID NO:1-187 are species election requirements; rather each of I-XIV and the elected sequence are restriction requirements. The subject matter for examination will be restricted to the extent of the subject matter of the elected groups.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.



Sharon L. Turner, Ph.D.
November 5, 2003